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May 30, 2007
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Re: Application of: White
           Serial No.:   09/678,885
           Filed: October 3, 2000
           For: Selective Omission Of Transaction Data In A
                                 Digital Receipt
           Group Art Unit: 3627
           Confirmation No.:   4770
           Examiner: Andrew J. Rudy
           MMB Docket No.:   1001-0700

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejection in the above-identified application. No

amendments are being filed with this request. This request is being filed with a Notice of

Appeal. The review is requested for the reasons stated on the attached sheets. This paper is

filed by the Attorney of Record.

REMARKS

I.   Reasons for Review

The Examiner has failed to make out a prima facie case of obviousness with respect to claims 1, 4-6, and 9-10. In general, the clear error in the Examiner's rejection is that none of the cited references disclose or suggest the limitation that a retail terminal receives input from a person at the retail terminal that identifies purchase transaction datum for omission from a digital receipt formatted with the retail terminal. This or a similar limitation is present in all of the claims 1, 4-6, and 9-10.

A.   Discussion of Missing Limitation

All of the claims relate to a method for generating a digital receipt with a retail terminal from purchase transaction data *and* receiving from a person at the terminal data that identifies data to be omitted from the digital receipt. The personalized digital receipt is sent over a network coupled to the retail terminal to a device associated with the person who provided the data identifying the transaction data to omit. The digital receipt that contains all of the purchase transaction data formatted by the retail terminal is transmitted to a storage location for the merchant. The "receiving at a retail terminal input …that selectively identifies purchase transaction datum for omission" limitation and the "forwarding the personalized digital receipt by the retail terminal over a network" limitation are set forth in independent claim 1. Similar limitations are also presented in the other independent claim 6. Claims 1 and 6 are set out in the Response to Office Action mailed January 25, 2007.

B.   The Examiner's Rejection

The Examiner relies upon U.S. Patent No. 7,158,948 to Rodriguez et al. (hereinafter "Rodriguez") and official notice "that retail terminals used with electronic cards has been

common knowledge in the art." The Examiner has taken the official notice because

"Rodriguez does not specifically disclose a retail terminal." This statement is evidence that

the Examiner has not closely read Rodriguez as Rodriguez does suggest the use of a retail

terminal with a scanner for communicating with the safe card disclosed in Rodriguez.

Specifically, Rodriguez states that "merchant scanner 327 may be similar to a barcode scanner

normally found connected to electronic cash registers." *Rodriguez*, col. 6, lines 28-30. Again,

Rodriguez discloses that "[s]afe card 360 receives e-receipt 359 through merchant scanner

352, which may be similar to a barcode scanner normally found connected to electronic cash

registers or to an ATM." *Rodriguez*, col. 6, lines 60-63. Also, Rodriguez describes a user

station that enables a user to input data that may be necessary for using the smart card as

resembling "systems that are frequently found in supermarket checkout stations." *Rodriguez*,

col. 7, lines 8-9. These electronic cash registers and supermarket checkout stations are

suggested as being used with the safe card of Rodriguez when he says, "a user completes a

purchase at a cash register location within the merchant's facilities" in the description of a

process in which the safe card of Rodriguez is used for the pick up of goods purchased at the

cash register location. Thus, Rodriguez does at least suggest the use of a retail terminal with

the safe card system disclosed in his patent.

Why is Applicant making this point? Because it demonstrates that the Examiner has

not carefully read Rodriguez. The reading of the cited reference in the Office Action displays

a failure to detect what is truly disclosed or suggested in the reference *and* the impermissible

use of hindsight to find in the cited reference what is taught only by Applicant's specification.

The Examiner's expansive reading of Rodriguez results in the Examiner's suggestion in the

Office Action that Rodriguez discloses the selective omission of identified purchase

transaction data from an e-receipt during a purchase transaction. While Rodriguez does

disclose that a user may edit an e-receipt *stored* in the safe card using an e-receipt application

executing on the smart card, *Rodriguez*, col. 4, lines 47-50, it does *not* teach or suggest that a

user may enter data *at a retail terminal* to identify data to be omitted from an e-receipt so the

edited (personalized) e-receipt is stored *by the retail terminal* on the card and the unedited

version is transmitted *by the retail terminal* for storage in the merchant's records. Instead, all

that Rodriguez discloses or suggests is that once the merchant station has stored an e-receipt

on the safe card, the user may later use the input control buttons, display, and e-receipt

application *on the safe card* to edit and store an edited e-receipt on the card. This process is

performed off-line from any transaction system and does not occur in the context of a

purchase transaction being performed at a retail terminal.
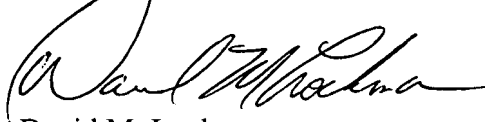
C.   Explanation of Clear Error

Applicant respectfully submits that the Examiner has not established that Rodriguez

teaches "receiving at the retail terminal input from a person at the retail terminal that

selectively identifies purchase transaction datum for omission from the digital receipt." All

that Rodriguez specifically teaches is that a user may use the input buttons, display, and e-

receipt of a safe card to retrieve, edit, and store an e-receipt on the card. Nowhere does

Rodriguez teach or even suggest that a user station associated with a merchant station can be

used to input data that identifies transaction data to be omitted by the merchant station from

an e-receipt so the revised e-receipt can be transferred by the retail terminal to the safe card

while the unedited version of the receipt is sent by the merchant station to the merchant server

for storage. The Examiner's assertion that Rodriguez does teach this type of operation is *not*

supported by the Examiner's citation of Rodriguez, col. 4, lines 45-59. Instead, Applicant's

specification is the only document of record in this case that enables one of ordinary skill in the art to input at a retail terminal data that selectively identifies transaction data to be removed by the retail terminal from a digital receipt. Examiner's use of Applicant's specification to interpret Rodriguez is impermissible and constitutes clear error.

II.   Conclusion

For all of the foregoing reasons, Applicant respectfully submits that the application is in a condition for allowance. Favorable reconsideration and allowance of this application is, therefore, earnestly solicited.

Respectfully Submitted,

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